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EXAMINER

LE, HUYEN D

ART UNIT PAPER NUMBER

3751

DATE MAILED: 12/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/810,821

Applicant(s)

GUERET, JEAN-LOUIS H.

Examiner

Huyen Le

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-80 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-11, 15, 17, 19, 21-24, 26-34, 36-43, 47-51, 55, 57, 59, 61-64 and 66-80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/29/2004</u> | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 4-6,12-14,16,18,20,25,35,44-46,52-54,56,58,60 and 65.

DETAILED ACTION

Election/Restrictions

1. Applicant's election of species III (Fig. 4), sub-species (Fig. 58) of group (a); and sub-species B (Fig. 68) of group (b) in the reply filed on 09/19/06 is acknowledged.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. It is noted claims 1-3, 7-11, 15, 17, 19, 21-24, 26-34, 36-43, 47-51, 55, 57, 59, 61-64 and 66-80 are readable on the elected species and sub-species.
3. Claim 14 is readable on Fig. 10.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 7-9, 15, 17, 22-24, 26, 39, 42, 43, 47-49, 55, 57, 62-64, 66, 78 are rejected under 35 U.S.C. 102(b) as being anticipated by Cansler et al (5,195,546).

The Cansler et al reference discloses an applicator for applying a cosmetic product comprising a plurality of applicator elements 14, wherein the plurality of applicator elements 14 comprises at least two applicator elements, wherein each of the at least two applicator elements 14 comprises at least one periodic pattern, wherein the

at least one periodic pattern comprises at least one undulation, and wherein at least two periodic patterns of the applicator elements are different from one another.

Regarding claim 2, the applicator elements are bristles.

Regarding claim 3, at least two different periodic patterns comprise at least one periodic pattern of one bristle and at least one periodic pattern of another bristle distinct from the one bristle.

Regarding claim 7, each of the at least two different periodic patterns comprises at least one undulation having an amplitude that is different from an amplitude of an undulation of another of the at least two different periodic patterns (Figs. 4A and 4B).

Regarding claim 8, each of the at least two different periodic patterns comprises at least one undulation having a spatial frequency that is different from a spatial frequency of an undulation of another of the at least two different periodic patterns.

Regarding claim 9, at least 1 percent of the bristles comprise the same periodic pattern.

Regarding claim 15, at least two of the bristles comprise lengths different from one another (Fig. 3).

Regarding claim 17, one of the bristles comprises a circular cross-section.

6. Claims 1-3, 7-9, 15, 17, 22-23, 26-28, 37, 39, 41-43, 47-49, 55, 57, 62-63, 66-68, 76, 78, 80 are rejected under 35 U.S.C. 102(b) as being anticipated by Cansler et al (5,195,555).

The Cansler et al reference discloses an applicator for applying a cosmetic product comprising a plurality of applicator elements 112, wherein the plurality of

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applicator elements 112 comprises at least two applicator elements, wherein each of the at least two applicator elements 112 comprises at least one periodic pattern, wherein the at least one periodic pattern comprises at least one undulation, and wherein at least two periodic patterns of the applicator elements are different from one another (when the wavy configuration is non-uniform).

Regarding claim 2, the applicator elements 112 are bristles.

Regarding claim 3, at least two different periodic patterns comprise at least one periodic pattern of one bristle and at least one periodic pattern of another bristle distinct from the one bristle.

Regarding claim 7, each of the at least two different periodic patterns comprises at least one undulation having an amplitude that is different from an amplitude of an undulation of another of the at least two different periodic patterns.

Regarding claim 8, each of the at least two different periodic patterns comprises at least one undulation having a spatial frequency that is different from a spatial frequency of an undulation of another of the at least two different periodic patterns.

Regarding claim 9, at least 1 percent of the bristles comprise the same periodic pattern.

Regarding claim 15, at least two of the bristles comprise lengths different from one another (Fig. 2).

Regarding claim 17, one of the bristles comprises a circular cross-section.

Regarding claims 28 and 68, the brush 110 comprises a twisted core 114 supporting the bristles 112.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 10, 11, 50, 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cansler et al (5,195,546).

Although the Cansler et al reference does not disclose that 20 percent to 80 percent or 30 to 60 percent of the bristles comprise the same periodic pattern, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select a percentage of periodic pattern of the bristles within a certain range to best fit a particular applicator design and to optimize the performance. See *In re Aller*, 105 USPQ 233, using the optimum or workable ranges involves only routine skill in the art.

9. Claims 19 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cansler et al (5,195,546) in view of EP 0651955.

Although Cansler et al does not disclose that the bristle includes a hollow cross-section, attention is directed to the EP 0651955 reference which teaches another applicator having a bristle with a hollow cross-section.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ hollow cross-sections bristles for the Cansler et al

applicator in view of the teaching of EP 0651955 for reducing material thus the weight and cost of the brush.

10. Claims 21 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cansler et al (5,195,546).

Although the Cansler et al reference does not explicitly disclose the diameter of bristles in the range of 0.05 millimeter to 0.4 millimeter, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select a diameter for the bristles within a certain range to best fit a particular (lipstick tube) design and to optimize the performance. See In re Aller, 105 USPQ 233, using the optimum or workable ranges involves only routine skill in the art.

11. Claims 27, 31, 32, 36, 37, 40, 41, 67, 71, 72, 75, 76, 79-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cansler et al (5,195,546).

Although the Cansler et al reference discloses that the bristles are used for application of make-up powder, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply other cosmetic substances to other parts of a user, such as eyelashes or nail wherein doing so would be a matter of obvious design choice.

Regarding claims 36 and 37, when the applicator is used for nail or eyelash/eyebrow, it would have been obvious to include a receptacle containing the nail product or eyelash/eyebrow product

12. Claims 29, 30, 69, 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cansler et al (5,195,546).

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Although the Cansler et al reference discloses that the bristles are secured to the brush by adhesive, stapling, overmolding or stamping, these securing means are known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to secure the bristles to the brush by aforementioned means wherein doing so would be a matter of obvious design choice.

13. Claims 10, 11, 50, 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cansler et al (5,161,555).

Although the Cansler et al '555 reference does not disclose that 20 percent to 80 percent or 30 to 60 percent of the bristles comprise the same periodic pattern, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select a percentage of periodic pattern of the bristles within a certain range to best fit a particular applicator design and to optimize the performance. See *In re Aller*, 105 USPQ 233, using the optimum or workable ranges involves only routine skill in the art.

14. Claims 19 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cansler et al Cansler et al (5,161,555) in view of EP 0651955.

Although Cansler et al ' 555 does not disclose that the bristle includes a hollow cross-section, attention is directed to the EP 0651955 reference which teaches another applicator having a bristle with a hollow cross-section.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ hollow cross-sections bristles on the Cansler et al

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applicator in view of the teaching of EP 0651955 for reducing material thus the weight and cost of the brush.

15. Claims 21 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cansler et al (5,161,555).

Although the Cansler et al '555 reference does not explicitly disclose the diameter of bristles in the range of 0.05 millimeter to 0.4 millimeter, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select a diameter for the bristles within a certain range to best fit a particular (lipstick tube) design and to optimize the performance. See *In re Aller*, 105 USPQ 233, using the optimum or workable ranges involves only routine skill in the art.

16. Claim 24 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cansler et al (5,161,555).

Although the Cansler '555 reference does not specifically show that the bristle is made of a material such as a natural fiber, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select natural fiber for the Cansler bristle, since selecting a known material on the basis of its suitability for the intended use is a mere matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

17. Claims 31, 32, 36, 40, 71, 72, 75, 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cansler et al (5,161,555).

Although the Cansler et al '555 reference discloses that the bristles are used as a mascara, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to apply other cosmetic substances to other parts of a user, such as nail wherein doing so would be a matter of obvious design choice.

Regarding claims 36 and 37, when the applicator is used for nail or eyelash/eyebrow, it would have been obvious to include a receptacle containing the nail product or eyelash/eyebrow product

18. Claims 29, 30, 69, 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cansler et al (5,161,555).

Although the Cansler et al '555 reference discloses that the bristles are secured to the brush by adhesive, stapling, overmolding or stamping, these securing means are known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to secure the bristles to the brush by aforementioned means wherein doing so would be a matter of obvious design choice.

19. Claims 33, 34, 73 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cansler et al (5,161,555) in view of Thayer et al (6,295,994).

Although Cansler et al '555 does not disclose the brush comprising a stem and a housing and the bristles secured to the housing, attention is directed to the Thayer et al reference which teaches another brush applicator having a stem 4 and housing at the end of the stem 4 (Fig. 4) and bristles secured to the end of the housing.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a stem and housing for the bristles of Cansler et al '55 brush in view of the teaching of Thayer et al for securing the bristles to the brush and make the brush as unit for easy holding.

20. Claims 39 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cansler et al (5,161,555) in view of Montgomery (4,403,624)

Although the Cansler et al '555 reference does not disclose a wiping member, attention is directed to the Montgomery reference which teaches another applicator having a wipe member for removing excess cosmetic product.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the Cansler et al applicator device with a wiper member in view of the teaching of the Montgomery reference for removing excess cosmetic product before applying.

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Babkowski teaches an applicator having wavy bristles.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huyen Le whose telephone number is 571-272-4890. The examiner can normally be reached on Monday-Friday from 9:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Huson, can be reached on 571-272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Huyen Le
Primary Examiner
Art Unit 3751

HL